

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOHN BARTHELOW CLASSEN

Appeal 2009-004501
Application 10/081,705
Technology Center 2100

DECISION ON PETITION

This is a decision on the “Petition Under 37 C.F.R. § 41.3 and 1.8(b) and Conditional Petition Under 37 C.F.R. § 1.183,” filed October 25, 2010 (“Petition”). The Petition requests that:

1. Papers mailed to the Office on August 1, 2008 be accepted as timely filed;
2. If necessary, waiver of the requirement of 37 C.F.R. § 1.8(b) that the Office be informed of its non-receipt of documents promptly after a party becomes aware of such non-receipt;
3. The Decision on Appeal entered August 23, 2010 be withdrawn; and
4. The Board again consider the appeal, including the papers mailed August 1, 2008 that were never received by the Office.

Filed with the Petition were supporting Declarations of Evelyn H. McConathy, James L. Gannon II, and Appellant John B. Classen, all dated

October 25, 2010, a Reply Brief and two substantive evidentiary Declarations, a Request for Oral Hearing, and a Request for Rehearing.

FINDINGS

1. Appellant filed an Appeal Brief on March 31, 2008.
2. The Examiner entered an Examiner's Answer on June 3, 2008.
3. In the Petition, Appellant's Attorney alleges that Appellant, via his attorney at the time, mailed a Reply Brief, two substantive evidentiary Declarations and exhibits, and a Request for Oral Hearing to the Office on August 1, 2008. Petition, ¶ 5.
4. The Reply Brief, substantive evidentiary Declarations, and Request for Oral Hearing have never been received by the Office.
5. On August 23, 2010, the Board of Patent Appeals and Interferences ("Board") mailed a Decision on Appeal ("Decision") affirming the Examiner's rejection of the pending claims.
6. The Declaration of attorney Evelyn H. McConathy, submitted in support of the Petition, provides sufficient facts to establish that the Reply Brief, substantive evidentiary Declarations, and Request for Oral Hearing were mailed to the Office via first class mail on August 1, 2008. McConathy Declaration, ¶¶ 5-6, 9-11.
7. Based on her prior experience, Ms. McConathy believed that eventually her firm would receive the return post card that was included with the papers mailed on August 1, 2008, and that the post card was necessary to establish that such mailing had occurred. McConathy Declaration, ¶¶ 13-14.

RELEVANT AUTHORITY

In respect to non-receipt of papers mailed to the Office, 37 C.F.R. § 1.8(b) provides:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed or decided with prejudice, or the prosecution of a reexamination proceeding is terminated pursuant to § 1.550(d) or § 1.957(b) or limited pursuant to § 1.957(c), or a requester paper is refused consideration pursuant to § 1.957(a), the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing, transmission or submission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement. If the correspondence was transmitted via the Office electronic filing system, a copy of an acknowledgment receipt generated by the Office electronic filing system confirming submission may be used to support this statement.

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

In respect to waiver of the rules, 37 C.F.R. § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

In respect to evidence submitted with a reply brief, 37 C.F.R. § 41.41(a)(2) specifies:

A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.

DISCUSSION

Appellant's Request for Rehearing was timely filed on October 25, 2010. Thus, the application remains under the jurisdiction of the Board.

The Decision in this appeal was arrived at following proper procedure. Thus, the Decision will not be withdrawn.

Appellant has presented sufficient facts to establish that an extraordinary situation exists which requires waiver of the prompt action requirement of Rule 1.8(b)(1). Specifically, the facts relating to the delay by Appellant's Attorney in advising the Office of its non-receipt of the papers mailed to the Office on August 1, 2008 constitutes such an extraordinary situation.

However, with respect to consideration of Appellant's Reply Brief, either as a result of waiving the prompt action requirement of Rule 1.8(b)(1) or on the Request for Rehearing, the Brief relies on two substantive evidentiary Declarations filed concurrently with the Brief. As set forth

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above, a reply brief shall not include any new evidence. Thus, irrespective of other issues, the Reply Brief is non-compliant and will not be considered.

DECISION

In view of the foregoing, the Petition is GRANTED to the extent that Appellant is granted a period of one month from the mailing date hereof to file a proper request for rehearing or take other appropriate action, e.g., file an RCE.

The Office acknowledges receipt of the fee for filing a petition under 37 C.F.R. § 1.183.

No action will be taken at this time on the Request for Oral Hearing. Should Appellant continue prosecution of this appeal, e.g., by filing a proper request for rehearing, the Board will entertain a petition to reconsider such Request.



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